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EXAMINER				
FARKHONDAR, FARIMA				
ART UNIT		PAPER NUMBER		
2681				

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/849,086

Applicant(s)

JOHANNESSON ET AL.

Examiner

Farima Farkhondar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22, 23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "the step of selecting" in page 15, line 1. There is insufficient antecedent basis for this limitation in the claim. The examiner has assumed this claim is a dependent of claim 21 in preparation of this office action.

Claim 23 recites the limitation "the step of receiving" in page 15, line 1. There is insufficient antecedent basis for this limitation in the claim. The examiner has assumed "the step of transmitting" in preparation of this office action.

Claim 23 recites the limitation "the step of transmitting" in page 16, line 1. There is insufficient antecedent basis for this limitation in the claim. The examiner has assumed this claim is a dependent of claim 21 in preparation of this office action.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinault et al., US Patent 5809416 in view of Turcotte et al., US Patent 5666650.

Regarding claims 1, 13, 21 Pinault discloses a method for selecting a public land mobile network to serve a mobile station (column 1, lines 10-14), comprising the steps of: at the mobile station a list of data associated with networks neighboring a PLMN currently serving the mobile station (column 2, lines 49-54, also column 4, line 61 to column 5, line 10, note when the mobile is in "when the mobile is located in a network in geographical entity of origin, that network is the serving PLMN); selecting a new PLMN to serve the mobile station from the PLMNs neighboring the PLMN currently serving the mobile station based upon the list of data (column 2, lines 49-54); and changing the mobile station to the selected new PLMN (column 2, lines 49-54). Pinault does not disclose that the list of data associated with neighboring networks is received at the mobile station. However, Turcotte discloses a list of data is received at the mobile station (column 3, lines 43-46). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the above teachings of

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Turcotte with Pinault, because unlike when the information is stored in the mobile station, when the information is sent to the mobile station it will include any updates and changes in SID of neighboring systems due to mergers of service providers of neighboring systems.

Regarding claims 2 and 27, the combination of Pinault and Turcotte further discloses the list of data further comprises a list of PLMNs neighboring the PLMN currently serving the mobile station (Pinault - column 2, lines 49-54).

Regarding claims 3, 14 and 28 the combination of Pinault and Turcotte further discloses the list of data further comprises a list of PLMNs adjacent to the PLMN currently serving the mobile station (Pinault - column 2, lines 49-54).

Regarding claims 4, 15, and 29, the combination of Pinault and Turcotte further discloses the list of data further comprises a list of PLMNs within a selected distance of the PLMN currently serving the mobile station (Pinault - column 2, lines 49-54).

Regarding claims 5 and 30, the combination of Pinault and Turcotte further discloses the list of data further comprises at least one mobile country code associated with a network neighboring the PLMN currently serving the mobile station (Pinault - column 4, line 61 to column 5, line 10).

Regarding claims 6 and 22, the combination of Pinault and Turcotte further discloses the step of selecting further comprises the step of: determining if the at least one mobile country code is associated with a preferred PLMN of the mobile station; and selecting the preferred PLMN of the mobile station as the new PLMN if the mobile country code is associated with the preferred PLMN (Pinault – column 4, line 61 to column 5, line 10).

Regarding claims 7 and 24, the combination of Pinault and Turcotte further discloses the preferred PLMN comprises a home PLMN of the mobile station (Pinault - column 4, lines 61-64).

Regarding claims 8-12 and 16-18, 23, and 25, the combination of Pinault and Turcotte further discloses the step of receiving and transmitting occurs only near a border of a country, on a periodic basis, on substantially continuous basis, during registration, in a MM information message. The combination of Pinault and Turcotte does teach broadcasting a list to a mobile station, but fails to particularly teach where and how often to broadcast the above list as recited in the claims (note the MM information message takes place during location updating and authentication). However, the examiner believes that the above recitations would not render the claims patentable over the applied references because they merely depend on where and how often one would like to broadcast the list, without changing the scope of the invention in the applied references. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention, to broadcast the system list at various locations or times in

order to have flexible and various ways of broadcasting the system list to the mobile station.

Regarding claim 19, the combination of Pinault and Turcotte further discloses the list of neighboring PLMNs further includes access technology (Turcotte - see Figure 3, analog and digital technologies).

Regarding claim 20, the combination of Pinault and Turcotte further discloses the step of selecting further comprises the steps of: determining a better PLMN exists for serving the mobile station from the list of neighboring PLMNs; and scanning for the better PLMN (Pinault – column 4, lines 61 to column 5 line10).

Regarding claim 26, Pinault discloses a mobile terminal comprising: circuitry for wirelessly connecting the mobile terminal to a serving PLMN network; a neighbor list containing data enabling selection of a PLMN neighboring the serving PLMN as a new serving PLMN (column 2, lines 49-54, and column 1, line 59 to column 2, line 22, also see Figure 1); and control logic for selecting the new serving PLMN responsive to the data of the neighbor list (Figure 1, control circuit 4, see also column 4, line 61 to column 5, line 10). Pinault does not disclose the neighbor list containing the data is received from the serving PLMN. However, Turcotte discloses the data is received at the mobile station (column 3, lines 43-46). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the above teachings of

Turcotte with Pinault, because unlike when the information is stored in the mobile station, when the information is sent to the mobile station it will include any updates and changes in SID of neighboring systems due to mergers of service providers of neighboring systems.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US005761618, Lynch et al., Updating technique for downloading new system identification (SID) list into a handset. A cellular telephone system is upgraded by modifying subscriber units for selective service provider acquisition during roaming. Priority of acquisition is given to those service providers associated with the home service provider. These preferred service providers are identified by System Identification (SIDs) numbers. A roaming subscriber unit will tune to control frequencies to identify all of the system providers operating in a physical area to which the subscriber has roamed. The SIDs of those system providers available are compared to a preferred SID list contained within the subscriber unit. Selection is made based upon a priority of those system providers having arrangements with the home system provider. The SID lists in the subscriber units are modified based upon a version number for each update on the SID list.



US005915214, Reece et al., Mobile communication service provider selection system. A system and method for enabling a user of wireless communication services such as mobile cellular telephone services to easily switch among various available service providers based on real time cost and service feature information. A central processing facility serves as an intermediary between mobile communication users and service providers and broadcasts real time service provider information over an established information channel, in each region served by wireless communication carriers. Users are able to select an optimal service provider based on the received service provider information. In this way, competition among wireless carriers is enhanced.

US006405038, Barber et al., Cellular carrier selection system incorporating a preferred list of system identification codes (SIDs) corresponding to preferred cellular carriers. A method and an apparatus for selecting a cellular carrier frequency for accessing cellular airtime services based upon a list of preferred system identification codes (SIDs). A cellular telephone is programmed to accept into memory a list of preferred SIDs corresponding to carriers through which service is preferred. While any SID remains in a preferred list, the standard A/B system selection function is replaced by a substitute system selection function, which includes only three carrier selection modes including the Home Only mode, the SID Only mode, and a Roam Saver mode. With the Roam Saver carrier selection mode, the cellular telephone first prefers service through a home carrier and then through a carrier broadcasting a SID matching a SID

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on the preferred list, but never denies service to emergency or non-emergency destinations if any SID is detected. Status indicators are used to, among other purposes, differentiate between no service being available, service being available through a carrier broadcasting a home SID, a preferred SID, or a non-preferred available SID. Also, in addition to multiple number assignment modules (NAMs) being included to support subscriptions to services from multiple carriers, the user is provided the option of manually selecting which NAM is used or enabling the cellular telephone, through an auto-NAM function, to automatically select and use the NAM of any home carrier detected by the cellular telephone.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farima Farkhondar-Tonsey whose telephone number is 703-305-6285. The examiner can normally be reached at 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vo Nguyen can be reached on 703-308-6728. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service whose telephone number is 703-306-0377.

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Farima Farkhondar-Tonsey

Examiner

February 3, 2004



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PRIMARY EXAMINER